## REMARKS

In the present amendment, claims 8 and 15 have been amended, claims 1, 2, 9, 10, and 16-30 have been canceled, and new claims 31-34 have been added. Accordingly, claims 8, 15, and 31-34 are pending in the application, with claims 8, 15, and 31 being independent claims.

Applicants emphasize that the amendment of claims 8 and 15 and the cancellation of claims 1, 2, 9, 10, and 16-30 are without prejudice or disclaimer, and Applicants expressly reserve the right to prosecute these claims in their original, unamended form in one or more continuation and/or divisional applications.

Applicants note that the amendment of the claims and the new method claims 31-34 are supported by the originally filed specification. No new matter has been added.

**Response to Claim Objections**

The Office Action objects to claims 2, 8-9, and 15 as containing non-elected subject matter. Applicants respectfully note that claims 8 and 15 have been amended by deleting or not referring to non-elected subject matter, specifically with respect to SEQ ID NOs: 3 and 4. Furthermore, as pointed out in more detail below, claims 2 and 9 have been canceled. Applicants respectfully request withdrawal of the objections.

**Response to Rejection under 35 U.S.C. § 112, first paragraph**

Claims 1 and 10 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description and enablement requirement.

In response, Applicants respectfully submit that in order to advance prosecution of the application, and without expressing agreement with or acquiescence to the rejections, claims 1 and 10 have been canceled, which makes this rejection moot.

The Office Action further rejects claims 8 and 15 under 25 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Action asserts that "while claims 8 and 15 are being enabling for use of an isolated host cell transformed" with a gene encoding O-glycan α2,8-sialyltransferase, the claims are, however, not enabling for use of any transgenic multi-cellular organisms or host cells within a multi-cellular organism.

In response, Applicants respectfully note that in order to advance prosecution of the application, and without expressing agreement with or acquiescence to the rejections, claims 8 and 15 have been amended to read: "*in vitro* culturing of isolated host cells transformed with an expression vector". In view of the present amendments, Applicants respectfully request withdrawal of the enablement rejections of claims 8 and 15.

**Response to Rejection under 35 U.S.C. § 102(a)**

The Office Action rejects claims 2, 8-9, and 15 under 35 U.S.C. § 102(a) as allegedly being anticipated by Takashima et al. (JBC., 101, Vol. 277, No.27, pp. 24030-24038, on-line publication April 29, 2002). The Office Action notes that the English language translation of the foreign priority document JP 2002-21159, filed on January 30, 2002, does not provide support for subject matter related to SEQ ID NOs: 3 and 4.

In response, and as already mentioned above, claims 2 and 9 have been canceled, and claims 8 and 15 have been amended by deleting or not referring to non-elected subject matter, such as SEQ ID NOs. 3 and 4. Accordingly, the presently claimed invention is fully supported by the foreign priority document, and withdrawal of the rejection under 35 U.S.C. § 102(a) is respectfully requested.

**Response to Rejection under 35 U.S.C. § 102(b)**

The Office Action rejects claims 1, 2, 9, and 10 as allegedly being anticipated by Kawai et al. (Nature, 2001, Vol. 409, pp. 685-690), hereafter "KAWAI".

Applicants respectfully note that in order to advance prosecution of the application, and without expressing agreement with or acquiescence to the rejections, claims 1, 2, 9, and 10 have been canceled. Therefore, the rejection under 35 U.S.C. § 102(b) is moot.

**Response to Rejection under 35 U.S.C. § 103(a)**

The Office Action rejects claims 8 and 15 as allegedly being obvious over KAWAI.

Applicants respectfully note that KAWAI reports results of a project that intended to analyze 21,076 cDNAs of mouse. Next to a large variety of polyynucelotides, KAWAI discloses a polynucleotide sequence having 100% homology to the polynucleotide of SEQ ID NO: 2 and further makes predictions with respect to the protein encoded by this polynucleotide. Applicants further note that KAWAI does not provide any additional teaching concerning the substrate specificity of the predicted polypeptide, nor does

KAWAI suggest to culture "*in vitro* isolated host cells transformed with an expression vector comprising a gene encoding a protein comprising amino acids 26 to 398 of the amino acid sequence shown in SEQ ID NO: 1". Applicants respectfully note that someone skilled in the art would not be motivated by the teaching of KAWAI to isolate the protein of the presently claimed invention or to develop a recombinant vector that produces a protein comprising SEQ ID NO: 1 in host cells.

Accordingly, Applicants respectfully request withdrawal of the obviousness rejection with respect to claims 8 and 15.

## CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition of allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully Submitted,
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